

attribute of an image-based product and incorporating at least a portion of the first image, based on the image attribute (col 4, lines 44-55); and receiving an order for the image-based product (FIG 1)." Office Action at page 5.

The text of the flowchart in Morag's FIG.1 shows: acquire images; send images to a service provider; send instructions to service provider; generate album; send proof album to customer; check for acceptability; print album and mail album to customer. The cited text at Column 4 is reproduced below:

In a preferred embodiment of the invention, the method comprises processing at least one of said images. Preferably, processing comprises motion deblurring of said image. Alternatively or additionally, processing comprises color correcting of said image. Alternatively or additionally, processing comprises histogram equalization of said image. Alternatively or additionally, processing comprises generating a composite image of a plurality of said images. Preferably, generating a composite image comprises generating an image mosaic from a plurality of overlapping ones said images. Preferably, said analyzing comprises determining overlaps between said images. Col. 4, lines 44-55.

In accordance with the foregoing, Morag shows a system that processes one or more received images in accordance with instructions from the customer, creates a proof album based on the instructions, sends the proof album to the customer for approval, and prints/mails the album to the customer. Here, Morag's album orientation requires the customer or the service provider to make a decision about the layout of the album. In particular, the exemplary flowchart on the front of the Morag patent shows: Get Images and Text, Get Format and Instructions, Determine Optimal Layout, and Generate Proof Album.

The invention is completely different. Hence, Applicant respectfully traverses the Section 102 rejection since at least two claimed elements are missing. The text of claim 1 requires:

automatically identifying an attribute of a first image;  
automatically selecting a new value, for a product attribute of an image-based product incorporating at least a portion of the first image, based on the image attribute;  
and  
receiving an order for the image-based product.

Turning now to the first element of claim 1, the "automatically identifying an attribute" is discussed for one implementation on page 15, lines 2-9 of the instant Specification as: "[a] set of attributes for the image-based product (also referred to here as "product attributes") is received (block 302). In the case of an image print, the product attributes can include, for example, the size of the image print, the number and identity of the images included in the image print, cropping information, and the size, style, and color of any border surrounding the image portion

of the image print. The set of attributes can be received from the user, for example, by having the user enter or select attributes using a browser executing on the client computer 104. Also, the set of attributes can be retrieved from storage, for example, from a database, or otherwise provided."

In the implementation, the automatically selecting a new value is discussed as follows:

As shown in FIG. 20, changing one or more attributes of an image-based product involves selecting which product attributes to change (block 2002) and then selecting a new value for the selected attributes (block 2004). Both of these operations can be performed manually by a user (e.g., where the user actuates one or more controls in order to select which product attributes to change and/or to select a new value for the selected attributes) or automatically by the system 100 (e.g., where the system 100 is commanded by the user or otherwise to select which product attributes to change and/or to select a new value for the selected attributes). For example, the system 100 can automatically select the one or more product attributes to change at random. In addition, or instead, the system 100 can automatically select one or more of the product attributes to change based on information relating to the user's images, past transactions, and account information. For example, the system 100 can select one or more product attributes that the user's account information indicates the user has not tried changing (perhaps, because the user was unaware that the particular attribute could be changed). Also, the system 100 can select new values for the selected product attributes at random and/or based on information relating to the user's images, past transactions, and account information. In this way, the system 100 suggests new ways to incorporate a user's image in an image-based product. The automatic selection of which product attributes to change and the automatic selection of a new value for the selected attributes can be performed by any component of the system 100 (e.g., by the server 102 and/or the client computer 104).  
Specification at page 15, line 25- page 16, line 13.

As discussed on page 8, line 8 of the specification, "advantages that can be seen in implementations of the invention include one or more of the following. Generating and displaying a preview image of an image-based product allows a user to see how the image-based product will look with a particular set of product attributes. In this way, the user can determine if the user wishes to order such an image-based product and/or modify one or more of the attributes of that image-based product. For example, a preview image of an image print can be generated

from an image selected by the user. The user can change one or more attributes of the image print, for example, the minimum border width, border style, border color, and print size."

The present system addresses the selection and showing of a particular image before an order has been placed to aid a prospective customer in making a purchase decision. This stands in sharp contrast to the post-order sequence exemplified in the flowchart on the front of the Morag patent showing: Get Images and Text, Get Format and Instructions, Determine Optimal Layout, and Generate Proof Album.

In sum, the independent claims cannot be anticipated by Morag since Morag does not show the automatically identifying an attribute of a first image. As an additional independent basis for traversing the Section 102 rejection is that Morag does not show the automatically selecting a new value, for a product attribute of an image-based product incorporating at least a portion of the first image, based on the image attribute. As yet an independent basis for traversing the section 102 rejection is that Morag's receiving an order for the image-based product is done at the wrong sequence since Morag receives the order first before it generates an album (and not one image) for approval.

Since the independent claim 1 is not anticipated by Morag, none of the dependent claims can be anticipated by Morag. Withdrawal of the rejections on claims 1-17, 20-23, 33-38, and 41-44 under Section 102(e) as anticipated by Morag is respectfully requested.

### **The §103 Rejections**

Claims 24-25, 28-32, 39, 40 and 43 were rejected under 35 USC 103(a) as unpatentable over Morag. Claims 18-19 were rejected under Section 103(a) as unpatentable over Morag and Lo (5,365,252). Claims 26-27 were rejected under Section 103(a) as unpatentable over Morag and Jamzadeh (5,140,348). Finally, claims 45-51 were rejected as unpatentable over Morag and BusinessWire. As discussed below, none of the references singly or in combination can render any of the claims obvious.

Lo shows a digital color image display system adapted to a frame buffer for displaying color images. The system includes apparatus for color quantization. The color distribution of a color image is stored in a memory device (HISTTABLE). Each pixel can be mapped into one of the addresses of the memory device according to its three basic color bits (red, green and blue); and the three basic color bits form a color universe cell in a 3-dimensional space. To select 256 colors from a color image, the color universe cell is divided into 256 color cells according to the color distribution. Because the special address arrangement of the memory device, the division of

the color universe cell can be easily accomplished by flipping one bit of the index to the memory device, thus increasing the speed to select 256 colors and reducing complexity of the hardware.

Jamzadeh relates to an electrostatographic color image production apparatus that forms a series of large color separation electrostatic latent images of a multicolor image on an image member. Each large latent image is made up of an array of smaller latent images with border regions therebetween. Latent images are formed in the border regions to create a border color in one of the dominant colors of the multicolor image.

BusinessWire is a news release from Sound Vision, Inc. that announces the introduction of Album Builder, a software which allows users to quickly build composite pictures of digital pictures and accompanying text that can be either printed or shared via email or web applications.

In sum, the Lo and Jamzadeh references relate to hardware devices which bear no relationship to the invention, while the BusinessWire article is similar to Morag.

None of the references show the specifics and the sequence of: automatically identifying an attribute of a first image; automatically selecting a new value, for a product attribute of an image-based product incorporating at least a portion of the first image, based on the image attribute; and receiving an order for the image-based product. Hence, the references singly or in combination cannot render independent claim 1 and those dependent therefrom obvious.

**Per MPEP 706.02(j): Contents of a 35 U.S.C. 103 Rejection**

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP Section 2143 - Section 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention *parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP Section 2144 - Section 2144.09 for examples of reasoning supporting obviousness rejections.

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Applicants submit that there is no suggestion to modify Morag to arrive at the invention as claimed. There is no reasonable expectation of success since. Moreover, the references singly or in combination, does not teach or suggest all the claim limitations in the independent claims as well as each dependent claims. Since the teaching or suggestion to make the claimed combination and the reasonable expectation of success is not found in Morag, there is an inference that it came from Applicants' disclosure.

In sum, since none of the references show the claimed elements recited in the claims, Applicant submits that they cannot render obvious independent claim 1. The dependent claims are allowable since they depend from allowable independent claims.

#### CONCLUSION

Applicants respectfully submit that all claims are in condition for allowance. Withdrawal of the rejection is respectfully requested. If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

  
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